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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. |
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| <input type="checkbox"/> | ART UNIT | PAPER NUMBER |
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DATE MAILED:

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

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|--------------------------------------|----------------------------------|
| Application No. 08/828,022 | Applicant(s) Saffarlan |
| Examiner Jamara Franklin | Group Art Unit 2876 |



Responsive to communication(s) filed on Jun 12, 2000

This action is **FINAL**.

Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle* 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

Claim(s) 1-11 and 13-30 is/are pending in the application.
Of the above, claim(s) _____ is/are withdrawn from consideration.

Claim(s) _____ is/are allowed.

Claim(s) 1-11 and 13-30 is/are rejected.

Claim(s) _____ is/are objected to.

Claims _____ are subject to restriction or election requirement.

Application Papers

See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

The drawing(s) filed on _____ is/are objected to by the Examiner.

The proposed drawing correction, filed on _____ is approved disapproved.

The specification is objected to by the Examiner.

The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

All Some* None of the CERTIFIED copies of the priority documents have been received.

received in Application No. (Series Code/Serial Number) _____

received in this national stage application from the International Bureau (PCT Rule 17 2(a))

*Certified copies not received: _____

Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

Notice of References Cited, PTO-892

Information Disclosure Statement(s), PTO-1449, Paper No(s) _____

Interview Summary, PTO-413

Notice of Draftsperson's Patent Drawing Review, PTO-948

Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

DETAILED ACTION

Acknowledgment is made of the amendment received on 6/12/00.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1, 2, 5, 27, and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Clary (US 5,187,351).

Clary discloses an automated system for encoding on the face of a check, at a point-of-sale, comprising: a point-of-sale register operable to determine a transaction amount; and input device coupled to the point-of-sale register and operable to receive the transaction amount and determine a check amount in response to receiving an input from a user (abstract; col. 2, lines 39-68).

Clary fails to specifically disclose that the encoder is coupled to the point-of-sale register and input device and operable to receive the check amount and encode the check amount in a

machine-readable format on a MICR line of the check. Clary does, however, disclose that the retail store may also operate its own MICR format on the MICR line (col. 3, lines 1-6; col. 4, lines 6-10; col. 5, lines 21-56; fig.4).

Therefore, in view of Clary's teachings, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to couple the MICR encoding center to the POS terminal, so that the amount of the check can be encoded on the spot. The advancements in technology have made MICR encoders readily available, such advancements have reduced encoder sizes as well as their costs. This has made it feasible to adapt encoders to POS terminals within them or as supplements. Therefore, to couple both devices (MICR encoder and POS terminal) in one same place, would have been obvious to one of ordinary skill in the art at the time the invention was made. This would have been done with the purpose of reducing bank processing costs since the dollar amount would already be printed in MICR code on the face of the check.

Regarding claim 2, Clary meets the claimed invention of the check encoder comprising a magnetic ink encoder capable to encode the check amount in magnetic ink (col. 5, lines 50-56).

Regarding claim 5, wherein it is claimed that the check is a blank check, Clary fails to teach such claimed limitation. However, POS terminals having the capability of accepting blank checks and therein filling all the requisite information on its surface are notoriously well known and commonly used in the art. Therefore, to modify Clary's device so that it has such capability, would have been obvious to one of ordinary skill in the art at the time the invention was made.

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This would have been done with the purpose of facilitating the decoding of information printed on the check since it could be easily read by the processor.

3. Claim 3, 4, 7-9, 29, and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Clary in view of Carlson (US 5,053,607).

Clary has been discussed above, it fails to disclose the presence of a keypad having a plurality of numeric and function keys.

Carlson teaches a keypad having a numeric and function keys (col.17, lines 13-50). In view of Carlson's teaching, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to employ a keypad to the teachings of Clary. This would have been done with the purpose of allowing the user of the device to key in information regarding the transaction, such as transaction amount, date, routing numbers, etc.

Regarding claim 4, Clary also fails to disclose the presence of a display. Carlson teaches such claimed limitation (col. 18, lines 61-68). In view of Carlson's teachings, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to provide a display to Clary's device with the intent of permitting the user of the device to verify that the amount to be printed on the check corresponds to the amount of the transaction.

Regarding claims 7 and 8, Clary fails to teach the limitation of printing a payee name on the face of the check and at a predetermined location on the check.

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Carlson teaches all such claimed limitations (col. 9, lines 12-46). In view of Carlson's teachings, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to adapt all such steps to Clary. This would have been done with the purpose of permitting the user of the device to correct any mistakes prior to printing the check.

4. Claims 19, 21, 22, 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Foudos (US 4,053,735) in view of Clary.

Foudos discloses a pocket-size personal check encoder comprising: a keypad 42 having a plurality of keys operable to display the check amount from the user; a display 52 coupled to the keypad and operable to display the check amount entered by the user; and a check encoder coupled to the keypad and the display operable to receive the check amount from the keypad and encode the check amount (col. 4, lines 19-42).

Foudos fails to disclose that the encoded check amount is encoded in a machine readable format at a predetermined location on the check.

Clary teaches such claimed limitations (col. 2, lines 65-68; col. 3, lines 1-6; fig.4). Clary discloses a check encoder having the capability of encoding the check amount in a machine readable format at a predetermined location on the check. In view of Clary's teachings, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to modify Foudos' device so that it has the capability of encoding the check amount in a machine readable format at a predetermined location on the check. This would have been done with the

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purpose of expediting the processing of the check by a bank, since all the relevant information would be readily present on the check's surface.

5. Claims 20, 23, and 24 rejected under 35 U.S.C. 103(a) as being unpatentable over Foudos/Clary as applied to claim 19 above, and further in view of Yasui (US 5,583,783). The teachings of Foudos/Clary have been discussed above.

Foudos/Clary lack the teaching of a memory to store and recall a list of payee names.

Yasui teaches a checkwriter 1 which stores and recalls payee codes, inherently, within a memory. All payee codes are displayed on a template 7. The user selects the payee code of the entity to be payed and enters the code onto the keyboard so that the checkwriter 1 prints the corresponding name onto the payee field of the check (col. 5, lines 41-51 and col. 6, lines 17-20).

One of ordinary skill in the art would have readily recognized that storing the list of payees in a memory provides the user with a short-cut and time-saving method to printing the payees name in the payee field of the check. Therefore, it would have been obvious, at the time the invention was made, to modify the teachings of Foudos/Clary with the method of storing and recalling a list of payees as taught by Yasui.

6. Claim 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over Foudos/Clary as applied to claim 19 above, and further in view of Howard (US 4,635,219). The teachings of Foudos/Clary have been discussed above.

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Foudos/Clary lack the teaching of an alphabetic amount and numeric amount check amount printed on the check.

Howard teaches a calculating, transaction writer and recording device 10 which prints the alphabetic check amount and numeric check amount onto a check via a printhead 34 (col. 5, lines 40-51).

One of ordinary skill in the art would have readily recognized that the standard bank check requires the alphabetic check amount and numeric check amount printed on the check. The aforementioned method of printing the amounts onto the check is beneficial since there is less of a chance that the amount field will be incomprehensible due to poor handwriting. Therefore, it would have been obvious, at the time the invention was made, to modify the teachings of Foudos/Clary with the method of printing the alphabetic and numeric check amount onto the check.

Response to Arguments

7. Applicant's arguments filed 6/12/00 have been fully considered but they are not persuasive.

The input received from the user results in a barcode being printed onto the back of the check. This barcode is then optically read to receive and then print the check amount onto the face of the check. Thusly and as broadly recited, in view of claims 1, 6, 13, 19, and 27 the check amount *is* printed in MICR format onto the face of the check in response to the input received from the user, albeit, indirectly.

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Regarding applicant's arguments that it would not be obvious to use blank checks with Clary because it was not disclosed, the use of a blank form of check *is* disclosed (col. 2, lines 20-21), thus supporting the previous decree of obviousness.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). For this reason, in view of claims 3, 4, 7-9, 29, and 30, only Carlson's *keypad* (and not the entire Carlson reference) is to be considered as a modification to Clary's invention and, in view of claim 19, only Clary's *predetermined location of the encode check amount on the check* (and not the entire Clary reference) is to be considered as a modification to Foudos' invention.

8. Applicant's arguments with respect to claims 20-26 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jamara A. Franklin whose telephone number is (703) 305-0128 and email address is jamara.franklin@uspto.gov. The examiner can normally be reached on Monday through Friday from 8:00am to 4:30pm.

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The fax phone number for the organization where this application or proceeding is assigned is (703) 305-3594.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.

James A. Franklin
James A. Franklin
Assistant Patent Examiner
August 31, 2000

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Michael G Lee
Primary Examiner